

REMARKS

Claims 10, 12, and 14 to 23 are currently pending in the present application.

In view of this response, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

With respect to paragraph two (2) of the Final Office Action, claims 12 and 19 to 23 were objected to for informalities.

Accordingly, claims 12 and 19, from which claims 20 to 23 ultimately depend, have been rewritten to correct the informalities. Approval and entry are respectfully requested, as is withdrawal of the objections.

With respect to paragraph four (4) of the Final Office Action, claims 10, 12, 14 and 19 were rejected under 35 U.S.C. § 102(b) as anticipated by European Patent Application Publication No. EP 1 304 251 (“the Steinle reference”).

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the Final Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Final Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied art.” (*See* M.P.E.P. § 2112; emphasis in original; and *see Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

Claim 10 relates to a cruise control system for a motor vehicle, including the features of a stop-and-go function adapted to automatically keep the vehicle stopped, a shutoff

function adapted to automatically shut off the cruise control system when a brake pedal is being operated, the shutoff function non-operational if predefined conditions are met, including a condition that a velocity is not greater than a certain shutoff velocity, in which the shutoff velocity is greater than 0 but less than 10 km/hr.

The Steinle reference does not identically disclose (or even suggest) all of the features of claim 10. Instead, the Steinle reference at paragraph [0010] merely states the following:

While in the known related art, an activation of the service brake on the part of the driver (that is, normally a depression of the brake pedal) is always an absolute switch-off criterion for the speed control system, now a deviation is to be made from this existing principle *when the motor vehicle is at a standstill* but is otherwise ready for operation.

(Steinle, ¶ [0010]) (emphasis added).

Thus, the Steinle reference merely refers to a condition for the shutoff function being non-operational when the vehicle is at a *standstill*. However, nowhere does the Steinle reference even refer to the shutoff function being non-operational if the vehicle is still moving -- e.g., at a velocity that is not greater than a shutoff velocity of greater than 0 but less than 10 km/hr. Therefore, the Steinle reference does not identically disclose (or even suggest) all of the features of claim 10.

As to paragraph [0012] of the Steinle reference, the cited section merely refers to a situation in which a shutoff function has already been made non-operational because the vehicle is at a standstill. After this condition has already been met, the Steinle reference indicates possible conditions for manual switch-off of the system by a driver. Thus, the cited section of the Steinle reference merely refers to conditions by which a driver may manually override the non-operational state of the system switch-off. However, nowhere does the cited section of the Steinle reference disclose any condition for the shutoff function being non-operational other than when the vehicle is at a standstill.

Moreover, paragraphs [0017] and [0019] of the Steinle reference refer to a stop-and-go operation in which the speed control system automatically switches itself off. Thus, the cited sections of the Steinle reference indicate automatic shutoff of the speed control system during stop-and-go operation, which is directly opposed to the claimed subject matter in which the shutoff function is non-operational if predefined conditions are met, including a condition that a velocity is not greater than a certain shutoff velocity, in which the shutoff

velocity is greater than 0 but less than 10 km/hr. Accordingly, the Steinle reference in fact teaches away from the features included in claim 10.

Accordingly, it is respectfully submitted that claim 10 is allowable, as are its dependent claims. Withdrawal of the rejections of the claims is therefore respectfully requested.

With respect to paragraph six (6) of the Final Office Action, claims 15 and 20 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of the Steinle reference and U.S. Patent No. 5,771,481 (“the Gilling reference”).

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

As explained above, the Steinle reference does not disclose (or even suggest) all of the features of claim 10. Claims 15 and 20 ultimately depend from claim 10, and they are therefore allowable for essentially the same reasons provided above, since the Gilling reference does not cure - and is not asserted to cure - the critical deficiencies of the Steinle reference. Withdrawal of the rejections of the claims is therefore respectfully requested.

With respect to paragraph seven (7) of the Final Office Action, claim 16 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of the Steinle reference and U.S. Patent No. 5,749,427 (“the Satonaka reference”).

As explained above, the Steinle reference does not disclose (or even suggest) all of the features of claim 10. Claim 16 depends from claim 10, and it is therefore allowable for essentially the same reasons provided above, since the Satonaka reference does not cure - and is not asserted to cure - the critical deficiencies of the Steinle reference. Withdrawal of the rejection is therefore respectfully requested.

With respect to paragraph eight (8) of the Final Office Action, claim 17 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of the Steinle reference and U.S. Patent No. 4,867,288 (“the Simonyi reference”).

As explained above, the Steinle reference does not disclose (or even suggest) all of the features of claim 10. Claim 17 depends from claim 10, and it is therefore allowable for essentially the same reasons provided above, since the Simonyi reference does not cure - and is not asserted to cure - the critical deficiencies of the Steinle reference. Withdrawal of the rejection is therefore respectfully requested.

With respect to paragraph nine (9) of the Final Office Action, claim 18 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of the Steinle reference and U.S. Patent No. 6,332,108 (“the Hirasago reference”).

As explained above, the Steinle reference does not disclose (or even suggest) all of the features of claim 10. Claim 18 depends from claim 10, and it is therefore allowable for essentially the same reasons provided above, since the Hirasago reference does not cure - and is not asserted to cure - the critical deficiencies of the Steinle reference. Withdrawal of the rejection is therefore respectfully requested.

With respect to paragraph ten (10) of the Final Office Action, claim 21 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of the Steinle, Gilling, and Satonaka references.

As explained above, the Steinle reference does not disclose (or even suggest) all of the features of claim 10. Claim 21 ultimately depends from claim 10, and it is therefore allowable for essentially the same reasons provided above, since the Gilling and Satonaka

references, either alone or in combination, do not cure - and are not asserted to cure - the critical deficiencies of the Steinle reference. Withdrawal of the rejection is therefore respectfully requested.

With respect to paragraph eleven (11) of the Final Office Action, claim 22 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of the Steinle, Gilling, and Simonyi references.

As explained above, the Steinle reference does not disclose (or even suggest) all of the features of claim 10. Claim 22 ultimately depends from claim 10, and it is therefore allowable for essentially the same reasons provided above, since the Gilling and Simonyi references, either alone or in combination, do not cure - and are not asserted to cure - the critical deficiencies of the Steinle reference. Withdrawal of the rejection is therefore respectfully requested.

With respect to paragraph twelve (12) of the Final Office Action, claim 23 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of the Steinle, Gilling, and Hirasago references.

As explained above, the Steinle reference does not disclose (or even suggest) all of the features of claim 10. Claim 23 ultimately depends from claim 10, and it is therefore allowable for essentially the same reasons provided above, since the Gilling and Hirasago references, either alone or in combination, do not cure - and are not asserted to cure - the critical deficiencies of the Steinle reference. Withdrawal of the rejection is therefore respectfully requested.

As further regards all of the obviousness rejections, any Official Notice is respectfully traversed to the extent that it is maintained and it is requested that the Examiner provide specific evidence to establish those assertions and/or contentions that may be supported by the Official Notices under 37 C.F.R. § 1.104(d)(2) or otherwise. In particular, it is respectfully requested that the Examiner provide an affidavit and/or that the Examiner provide published information concerning these assertions. This is because the § 103 rejections are apparently being based on assertions that draw on facts within the personal knowledge of the Examiner, since no support was provided for these otherwise conclusory and unsupported assertions. (See also MPEP § 2144.03).

In sum, claims 10, 12, and 14 to 23 are allowable.

CONCLUSION

It is therefore respectfully submitted that all of the presently pending claims are allowable. It is therefore respectfully requested that the rejections and objections be withdrawn, since all issues raised have been addressed and obviated. An early and favorable action on the merits is therefore respectfully requested.

Respectfully submitted,

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